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SCHWEGMAN, LUNDBERG & WOESSNER/EBAY			O'CONNOR, GERALD J	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20071126

Application Number: 10/666,681

Filing Date: September 18, 2003

Appellant(s): Speiser et al.

MAILED

DEC 11 2007

Andre L. Marais
(Reg. No. 48,095)
For Appellant

GROUP 3600

EXAMINER'S ANSWER

This examiner's answer has been prepared in response to appellant's brief on appeal
filed June 27, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(*eBay Inc.*)

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. (10/689,970.)

(3) Status of Claims

The statement of the status of claims contained in the brief is substantially correct.

(Claims 1-14 and 23-34 have been cancelled.)

(Claims 15-22 are pending, rejected, and appealed.)

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is substantially correct. (An after-final amendment was filed by appellant on June 21, 2006, and was entered by the examiner.)

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal contained in the brief is correct:

- I. Claims 15-22 are rejected under 35 U.S.C. 102(a) as being anticipated by Spiegel et al. (US 6,466,918).

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Evidence Relied Upon*

The following is a listing of the evidence (e.g., patents, publications, official notice, and admitted prior art) relied upon in the rejection of claims under appeal:

US 6,466,918

Spiegel et al.

10/2002

(9) *Grounds of Rejection*

- I. Claims 15-22 are rejected under 35 U.S.C. 102(a) as being anticipated by Spiegel et al. (US 6,466,918).

Spiegel et al. disclose a method of providing listing recommendations to users of a network-based commerce system including a plurality of listings 120 arranged in a plurality of

divisions 130, the method including: identifying a division 110 of the plurality of divisions 130 based on user interaction with the network-based commerce system; identifying at least one frequently used search term associated with the identified division 110; and providing a link to the user to listings 120 associated with each frequently used search term 110. See, in particular: col. 4, lines 43-67; col. 6, lines 5-60; col. 7, lines 6-67; col. 8, lines 33-59; and, Figure 1A.

Regarding claim 16, the method of Spiegel et al. includes communicating a web page to the user including a hyperlink to the listings associated with each frequently used search term. See, in particular, column 4, lines 61-65.

Regarding claim 17, in the method of Spiegel et al. the listings associated with each frequently used search term are listings that would be located if the user conducted a search of the network-based commerce system using each frequently used search term.

Regarding claim 18, in the method of Spiegel et al. the at least one frequently used search term is ranked in one of an ascending and descending order according to a number of occurrences of listings in a division associated with the at least one frequently used search term.

Regarding claim 19, the method of Spiegel et al. inherently includes periodically adding new listings and removing terminated listings prior to determining the number of listings in each division associated with each frequently used search term so that the ranking is dependent upon supply and demand for the listings.

Regarding claim 20, the method of Spiegel et al. includes searching the network-based commerce system using at least one frequently used search term when the user selects the link.

Regarding claim 21, in the method of Spiegel et al. the at least one frequently used search term is displayed according to rank in one of an ascending and descending order.

Regarding claim 22, in the method of Spiegel et al. one or more frequently used search terms are assigned to each of the plurality of divisions, the divisions being defined by categories.

(10) *Response to Argument*

I. Claims 15-22 are unpatentable under 35 U.S.C. 102(a) for being anticipated by Spiegel et al. (US 6,466,918).

Regarding the argument that Spiegel et al. fail to disclose “identifying at least one frequently used search term associated with the identified division,” Spiegel et al. indeed disclose “identifying at least one frequently used search term associated with the identified division,” for example, the frequently-used search term “Olympics” associated with the second identified division under “Featured Categories” in Figure 1. See, in particular, column 7, lines 6-67. Note that, although all claims have been interpreted in light of the specification, limitations from the specification have not been read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding the argument that Spiegel et al. fail to disclose “providing a link to the user to listings associated with the at least one frequently used search term,” Spiegel et al. indeed

disclose “providing a link to the user to listings associated with the at least one frequently used search term,” since the items/listings shown in Figure 1 are hyperlinks. See, in particular, column 4, lines 61-67. Note that, although all claims have been interpreted in light of the specification, limitations from the specification have not been read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

To the extent that appellant is arguing that the references applied in the rejection fail to use the same *names/words* for certain elements as the names used by applicant, the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but *need not be in the identical words* as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

To the extent that appellant is arguing that the disclosure in the applied prior art is not in as complete detail as is recited by the instant claims, a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings *in combination with his own knowledge* of the particular art and be in possession of the invention. *In re Graves*, 36 USPQ2d 1697 (Fed. Cir. 1995); *In re Sasse*, 207 USPQ 107 (CCPA 1980); *In re Samour*, 197 USPQ 1 (CCPA 1978).

(11) Related Proceeding(s) Appendix

No decision rendered by any court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

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For all of the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627

GJOC

November 26, 2007

Appeal Conference Held:

F. Ryan Zeender 
Supervisory Patent Examiner
Group Art Unit 3627

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